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PATENT AND TRADEMARK OFFICE

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APPLICATION OF
MARTIN G. REIFFIN)
FOR: COMPUTER SYSTEM WITH)
REAL-TIME CODE PROCESSING)
FILED: APRIL 3, 1985)
SERIAL NO. 719,507)

ART UNIT 232

EXAMINER T. LEE

PETITION TO THE COMMISSIONER

Applicant respectfully petitions the Commissioner of Patents and Trademarks in the exercise of his supervisory authority under 37 CFR 1.181 to direct:

1. That applicant's Reply Brief filed January 23, 1989 be entered;
2. That new Claims 57 to 67 submitted in the Amendment filed January 23, 1989 accompanying said Reply Brief be entered; and
3. That the Examiner render an advisory action as to whether said new Claims 57 to 67 are deemed allowable.

FACTS

This application is on appeal. Claim 53 was allowed. Claims 52 and 55 were deemed allowable if rewritten in independent form. Claims 51, 54 and 56 were rejected and are on appeal.

The rejected claims and the allowable claims are directed to the same combination and differ in specificity in that the rejected claims recite one of the combination elements broadly as a "code processor program" whereas the rejected claims recite the very same element in narrower terms as a "compiler".

In the Examiner's Answer (Paper No. 26) mailed December 1, 1988 new references to Maddock and Catiller et al. were cited and new grounds of rejection based thereon were relied upon. The Maddock reference was cited to show an entire system, rather than a mere element or subcombination. More specifically, the Answer asserted:

"... Maddock disclosed a system having the editing process and formatting process ran [sic] as two parallel processes with different priorities.

"Maddock explicitly taught a system with a reformatting process having a continuous control thereof until it was interrupted by the receiving of a keystroke." (Emphasis added.)

Applicant then filed his Reply Brief accompanied by an Amendment adding new Claims 57 to 67. These new claims are dependent upon rejected Claims 51, 54 and 56 on appeal.

New Claims 57 to 67 recite that the code processor program is a "language processor" and these claims are therefore midway in breadth between the narrower allowable "compiler" Claims 52, 53 and 55 and the broader rejected "code processor program" Claims 51, 54 and 56.

That is, in response to the new ground of rejection relying upon an entire "system" allegedly disclosed in a newly cited reference, applicant has merely added new claims directed to his very same combination but having a breadth midway between his narrower allowable claims and his broader rejected claims.

In Paper No. 30 mailed April 17, 1989 the Examiner refused entry of applicant's Reply Brief and apparently also intended to refuse entry of the accompanying Amendment.

ARGUMENT

The issue is whether applicant's response was "appropriate to the new ground" in accordance with 37 CFR 1.193(b) and MPEP 1208.03(2).

In Paper No. 30 mailed April 17, 1989 the Examiner's reliance upon Section 2 of MPEP 1208.03 is misplaced. The intent of this section is revealed by the citation in the section of Ex parte Abseck et al., 133 USPQ 411 (Supervisory Examiner, 1960). This is the sole citation in this section of the MPEP. In this decision the Supervisory Examiner ruled:

"A careful review of the record indicates that the examiner was justified in refusing to enter claims 27, 28, 33, 34 and 35. Claims 27 and 28 relate to the power source. Claims 33, 34 and 35 relate to the foot actuated switch. These features have no bearing with respect to the features (the paper receiving tray and the paper displaying column) for which the newly cited references were used. Rule 193 (b) states that if the Examiner's Answer states a new ground of rejection, appellant may file a reply thereto which 'may include any amendment or material appropriate to the new ground.' Claims 27, 28, 33, 34 and 35 do not involve matter appropriate to the new ground. They relate to features which are entirely distinct from the matters involved in the new ground of rejection."

It thus appears from the above quotation that Abseck et al. attempted to add claims directed to structures or elements ("power source" and "foot actuated switch") completely different from and unrelated to those structures for which the new references were cited ("paper receiving tray" and "paper displaying column") and to which the original rejected claims were directed. Abseck et al. were attempting to claim in the new

claims a combination "entirely distinct" from that originally claimed.

This is not the situation in the present case. Applicant's rejected claims recite an element as a "code processor program"; his allowable claims recite the very same element as a "compiler"; and the new claims in question recite the very same element as a "language processor".

Applicant, unlike Abseck et al., is not attempting to claim a different combination of structures. Instead, applicant is merely attempting to claim the very same combination in terms having a breadth midway between that of his rejected claims and his allowable claims.

This is not only "appropriate" to a new ground of rejection, but is indeed the usual, standard and proper response to a new reference by claiming the same combination in more specific language.

Furthermore, since the new claims are dependent upon the rejected claims and are midway in breadth between the rejected claims and the allowable claims, it cannot be seen that the new claims call for a new search or would impose an onerous burden on the Examiner.

The Examiner's assertion in Paragraph 2 of Paper No. 30 that the new ground of rejection was "directed to the interrupt aspect of the claimed invention" is not understood. The new ground of rejection was directed to applicant's entire claimed combination since this is what was claimed and what was rejected. Furthermore, the Maddock reference was cited for its disclosure of an entire "system" and was relied upon to reject applicant's

entire "system". In any event, the Examiner's contention, even if accurate, would nevertheless be irrelevant to the type of situation intended to be covered by MPEP 1208.03(2) as revealed by the Abseck et al. decision cited therein.

Respectfully submitted,

April 30, 1989.



Martin G. Reiffin,
Applicant
5439 Blackhawk Drive
Danville, CA 94526
Tel.: (415) 838-6980